

REMARKS

Preliminary Remarks

Upon entry of this Response, claims 41–47 and 49–61 will be pending, of which claims 41 and 60 are independent. Claims 1–40 were previously cancelled without prejudice or disclaimer. Claims 50–59 were previously withdrawn from consideration as being drawn to a non-elected invention. Claim 1 has been amended to incorporate the limitations of claim 48. Claim 48 is presently cancelled without prejudice or disclaimer. Claim 60 was withdrawn by the Examiner for allegedly not falling within the previously elected group of claims. Applicants respectfully submit that no new matter has been added by the present amendments.

Election/Restriction

The Examiner asserts that new claim 60 is drawn to a different method from that of group I, allegedly because it does not use stable isotopes or chemical modification. Applicants respectfully traverse.

In making a restriction requirement, the examiner must “provide a clear demarcation between restricted inventions” M.P.E.P. § 814. Here, the Examiner described Group I as follows: “Group I, claim(s) 41–49, drawn to method of identifying and quantifying tumor-associated peptides.” No further explanation was provided as to why these specific claims fall within this specific group. Thus, a claim would be consonant with the restriction requirement as long as it relates to “[a] method of identifying and quantifying tumor-associated peptides.” Claim 60 clearly falls within this group.

Nonetheless, the Examiner attempts to restrict claim 60 from the present application by drawing a further distinction based on the use of stable isotopes and chemical modification. Applicants respectfully submit that such a distinction goes well beyond the original restriction requirement and therefore is improper. If the Examiner wishes to further restrict the claims, Applicants respectfully submit that the proper course of action would be to issue a further restriction requirement. Applicants thus respectfully request that claim 60 be rejoined.

Priority

The Examiner has asserted that Applicant cannot rely on upon the foreign priority papers to overcome the present rejection under 35 U.S.C. § 102(a) because no translations have yet been

filed. Translated priority documents have been filed concurrently herewith. Applicants thus respectfully submit that they may rely on the foreign priority papers in responding to the 35 U.S.C. § 102(a) rejection.

Claim Rejections -- 35 U.S.C. § 102

The Examiner rejects claims 41–49 and 61 under 35 U.S.C. § 102(a) as being anticipated by Lemmel *et al.*, Nature Biotech., vol. 22, pages 450–454 (“Lemmel”). Applicants respectfully traverse.

The Lemmel reference is not prior art unless it was published before the effective filing date of the present application. The Lemmel reference was first published on March 7, 2004. The present application claims priority to DE 10 2004 005 273.5 and DE 10 2004 011 503.6, which have priority dates of January 24, 2004 and March 6, 2004, respectively. Applicants have perfected this claim to priority by filing English translations of the priority documents. Since both priority documents were filed before the Lemmel reference was publically available, Applicants respectfully submit that the Lemmel reference is not prior art to the present claims. Applicants thus respectfully request withdrawal of this basis for rejection.

Claim Rejections -- 35 U.S.C. § 103

The Examiner rejects claims 41–47 and 61 under 35 U.S.C. § 102(a) as being anticipated by Moritz and Meyer, Proteomics, vol. 3, pages 2208–2220 (“Moritz”). Claim 41 is currently amended to incorporate the limitations of claim 48, which was not included in the present rejection. The remaining claims depend, either directly or indirectly, from claim 41. Accordingly, the present basis for rejection has been overcome. Applicants respectfully request that this basis for rejection be withdrawn.

CONCLUSION

In view of the amendments and remarks above, Applicants respectfully submit that this application is in condition for allowance and request favorable action thereon. The Examiner is invited to contact the undersigned if any additional information is required.

As this response is filed within the shortened statutory period for reply, Applicants believe that no fees are due. If any additional fees are required, they may be charged to Deposit Account No. 50-4254, referencing Attorney Docket No. 2912919-006000.

Respectfully submitted,

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